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Paper No. 14
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re mental images G.m.b.H. & Co. KG

Serial No. 75/719,666

Richard A. Jordan for mental images G.m.b.H. & Co. KG.

Ellen J. G. Perkins, Trademark Examining Attorney, Law
Office 110 (Cris A.F. Pedersen, Managing Attorney).¹

Before Cissel, Wendel and Bucher, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On May 2, 1999, applicant, a corporation of the
Federal Republic of Germany, filed the above-referenced
application to register the mark "INCREMENTAL IMAGES" on
the Principal Register for "computer software for
education, educational and other games and accessing the
Internet and World Wide Web for use therewith, together
with instructional manuals and printed instructional and

¹ Although Ms. Perkins submitted the appeal brief in this case,
the original examination and all four Office Actions were the

teaching guides sold therewith as a unit," in Class 9. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in interstate commerce in connection with the specified goods.

The Examining Attorney raised several informalities, including that the identification-of-goods clause was indefinite and required amendment.

Applicant responded by amending the description of the goods with which it intends to use the mark. First an amendment proposed by applicant was entered; then an Examiner's Amendment was made, further clarifying the goods as "computer software for use by software developers in creating applications that provide for interactive visualization, manipulation and modification of three-dimensional digital content over worldwide global computer networks, together with printed instructional manuals and printed instructional and teaching guides sold therewith as a unit," in Class 9.

The Examining Attorney then refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to register is merely descriptive of the goods set forth in

work of Andrea Koyner Nadelman, an Examining Attorney in the same Law Office.

the application, as amended. In support of the refusal, she quoted dictionary definitions of "incremental" as "the process of increasing in number, size, quantity, or extent... something added or gained... a slight, often barely perceptible, augmentation;" and of "image" in the context of computers as "[a]n exact copy of data in a file transferred to another medium." She concluded that "INCREMENTAL IMAGES" "refers to a specific type of digital content," and that the mark is merely descriptive of the goods specified in the application because it "immediately names a feature and purpose of the goods and does nothing else," in that it "conveys to consumers and potential consumers that the applicant is providing computer software that creates incremental images."

Enclosed in support of the refusal to register were excerpts from several articles retrieved from the Nexis database wherein the terms "incremental" and "image" (or "images") appear together.

The first excerpt is from an article which appeared in the Sunday New York Times on May 18, 1986. In this book review, the author states as follows: "The incremental images add up to pictures; the verbal veil is lifted; the language becomes a bit less atmospheric and the story clearer." The second excerpt appears to be from an article

about charitable fundraising which appeared in July of 1985 in the DM News. In discussing the advantages of using television to raise funds, the author notes that "... when TV is made into a profitable source, the incremental image support for the organization is delivered for free." An excerpt from the April, 1996 edition of the Enterprise Systems Journal states that "[i]ncremental image copy gains the largest improvement because, by definition, 100 percent of the tablespace pages processed have been updated since the last copy..."

Responsive to the refusal to register, applicant argued that mark is not merely descriptive of the goods specified in the application. Applicant denied that its computer software creates incremental images, and argued that the examples of the use of the term provided by the Examining Attorney do not show descriptive use of it in connection with software of the type with which applicant intends to use the mark.

The Examining Attorney was not persuaded by applicant's arguments, however, and made the refusal to register final in the next Office Action. She included with this action excerpts from sixteen additional articles retrieved from the Nexis database, and concluded that applicant's software "is for use by software developers in

creating applications that provide for interactive visualization, manipulation and modification of three-dimensional digital content, or more concisely, incremental images. As such, the mark immediately identifies a feature of the goods."

All of these excerpts will not be recited here. What follows are three typical examples:

The Business Journal, 2000: "The company's incremental image overhaul has been noticed by investors."

JavaWorld, March 1996: "Where animation is concerned, incremental image display can be useful for background images, but it can be very distracting when used for the animated images."

Byte, October 1991: "User-definable filters let you set incremental image 'warpage' by pixel measurement."

The sources of several other excerpts are not entirely clear, in the sense that we cannot determine whether they are from published articles or are simply information retrieved from the Internet, but they show use of the term "incremental image copies" in ways that do not make its meaning clear. For example, one states that "[a]n incremental image copy contains only those pages in the tablespace that have been changed since the last copy operation was performed;" and "[t]he DB2 MERGECOPY utility can be used to combine multiple incremental image copies into a single incremental copy or to merge all the

incremental copies and the last full image copy into a single full image copy."

Applicant requested reconsideration of the refusal to register, arguing that its mark neither has a specific, recognizable meaning in the computer industry, nor conveys to consumers significant information about applicant's computer software.

The Examining Attorney reconsidered the refusal in light of applicant's arguments, but maintained that the mark applicant seeks to register is merely descriptive of the goods set forth in the application, as amended. Submitted with her response to applicant's request for reconsideration were additional excerpts from the results of searches on the Internet and of the Nexis database. The former include copies from various Web pages, but as with the other examples previously submitted, although the term "incremental images" appears to be used in connection with data files in data base applications, its meaning is not clear, nor is it clear that the public was ever exposed to this information for a significant period such that such uses of the term would be considered to be examples of common usage. For example, one excerpt states that "[t]he GIF files (including numerous incremental images that are not listed below) are stored in the ewporosv directory and

can be displayed as a slide show using an external viewer, such as JPEGVIEW or LVIEW." An article excerpted from the June 5, 2001 edition of PC Magazine does indeed seem to be directed to three-dimensional Web content creation. It states that "Caligari's new incremental image rendering (IIR) technique provides a near-real-time preview of the texture effects, which is critical when applying reflective and transparency shaders that are impacted by other scene objects."

Applicant timely filed a Notice of Appeal. Applicant then filed its appeal brief, the Examining Attorney filed her brief on appeal and applicant filed a reply brief. Applicant did not request an oral hearing before the Board.

At this juncture we note that applicant attached to its appeal brief evidence which had not been previously made of record in connection with this application. In her brief, the Examining Attorney objected to the Board's consideration of this additional evidence. In its reply brief, applicant argued that the additional evidence submitted with its brief should be considered because it was filed in response to the evidence submitted with the Examining Attorney's response to applicant's request for reconsideration.

We have not considered the evidence submitted with applicant's brief. Trademark Rule 2.142(d) provides that the record closes with the filing of a Notice of Appeal. The rule also outlines a procedure whereby either applicant or the Examining Attorney can be allowed to submit evidence after the appeal is filed. In the case at hand, however, applicant did not follow the procedure set forth in the rule, so the submission of the additional evidence attached to its brief was untimely. That applicant intended this evidence to be responsive to the evidence submitted by the Examining Attorney responsive to applicant's request for reconsideration is not a proper reason for not following the procedure set forth in the rule.

Based on careful consideration of the record before us in this appeal, the arguments presented by applicant and the Examining Attorney and the relevant legal authority on this issue, we hold that the Examining Attorney has not met her burden of establishing that the mark is merely descriptive of the goods set forth in the application within the meaning of Section 2(e)(1) the Lanham Act.

The test for determining whether mark is merely descriptive is well settled. A mark is merely descriptive under this section of the Act if it immediately and forthwith conveys information concerning a significant

quality, characteristic, feature, function, purpose or use of the goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods in order for it to be considered to be merely descriptive of them; rather, it is sufficient if the term describes any significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used (or is intended to be used) in connection with those goods and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use. See: In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the goods are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what attributes of the goods the mark indicates. In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984). As we have stated previously, there is a thin line of demarcation between a suggestive mark and a merely descriptive one, with the

determination of which category a mark falls into frequently being a difficult matter involving a good measure of subjective judgment. See, e.g., *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992), and *In re TMS Corp. of the Americas*, 200 USPQ 57 (TTAB 1978).

Another significant principle relevant to the case at hand is that the Examining Attorney bears the burden of establishing that a mark is unregistrable because it is merely descriptive of the goods within the meaning of Section 2(e)(1) of the Act. *In re Gyulay*, supra.

Simply put, the evidence submitted by the Examining Attorney falls short of meeting her burden in this regard. The evidence does not establish that the mark applicant intends to use conveys, with any degree of particularity or specificity, any significant information about the goods identified in the amended application. Many of the examples she submitted show the words "incremental image" or "incremental images" used in contexts unrelated to computers. Of the examples which do appear to show use of the term in connection with computer software, most refer to operations within data base applications. With the remaining excerpts, it is not at all clear to us what the term means, much less that it immediately and forthwith conveys information concerning any features, functions or

characteristics of applicant's computer software for use by software developers in creating applications that provide for interactive visualization, manipulation and modification of three-dimensional images over the Internet.

Moreover, as noted earlier in this opinion, although a few of the examples of use of the term "incremental images" made of record by the Examining Attorney might well support her position herein, upon weighing all the evidence in this record, we are not persuaded to adopt her position. In any event, doubt on this issue must be resolved in favor of the applicant, leaving competitors to oppose registration if the use of the term is necessary in order for them to compete effectively with applicant. In re Aid Laboratories, Inc., 221 USPQ 215 (TTAB 1983).

DECISION: The refusal to register is reversed.